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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/363,578	07/29/1999	JAE-YUL RYU	003364.P020	8304

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EXAMINER

RUTHKOSKY, MARK

ART UNIT	PAPER NUMBER
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1745

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DATE MAILED: 03/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/363,578

Applicant(s)

RYU ET AL.

Examiner

Mark Ruthkosky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Summary

1. Claims 1-6 are pending.

Claim Rejections - 35 U.S.C. § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The previous rejections under 35 U.S.C. 102(b) as being anticipated by Kuribayashi et al. and Liu et al. have been overcome by the applicant's amendment. A new rejection follows:

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Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kuribayashi et al. ("Battery Characteristics with Various Carbonaceous Materials," Journal of Power Sources 54 (1995) 1-5.)

The instant claims are to a carbonaceous active material for a lithium secondary battery comprising a crystalline, graphite core and an amorphous shell surrounding the graphite core. Differential thermal analysis displays two overlapping, exothermic peaks that form shoulders. A specific process makes the active material.

Kuribayashi et al. teaches a lithium secondary battery, which comprises particles with a graphite core, surrounded by an amorphous carbon shell. The particles have a graphite structural part and an amorphous type part (see page 1, lines 10-end). The shell is comprised of a coke-like carbon (page 1, col. 2, lines 10-15.) Example 1 and paragraph 1 on page 5 teaches the shell to be pitch-blended phenol resins. The mixture is also a solid solution. Agglomerates are shown in figures 4 and 5. Differential thermal analysis is a means for analyzing the carbon materials. Differential thermal analysis is not discussed in the Kuribayashi et al. reference; however, the properties indicated by differential thermal analysis would be inherent. The carbonaceous material would have two, separate, inherent, exothermic peak values based on the graphite material and the non-graphite material. The instant specification does not describe specific graphite and amorphous materials. See, for example, page 5, where it is noted that natural or artificial graphite may be used and various amorphous carbons serve as the other carbon material. The specification discloses that it is known in the art that crystalline graphite has an exothermic peak at 800 °C and that amorphous carbon has an exothermic peak at 700 °C. Thus,

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the graphite and carbon core materials will inherently have two specific peaks by DTA and the claims are anticipated.

Kuribayashi et al. does not teach the process for making the active material. It is noted that MPEP 2113 states, "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process."

NOTE: THIS SPACE CANNOT BE
REMOVED FROM THE WORD FILE.

(WR)

Response to Arguments

3. Applicant's arguments with respect to claims 1-6 have been considered but are not persuasive.

The amendment to the claims adds a process for preparing the electrode material. It has been noted that the MPEP 2113 states, "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." From this, it is clear that the determination of patentability is based on the product and not the method of production. Further, it is noted that Kuribayashi et al. does not teach against dissolving the amorphous carbon material in a solvent. It simple teaches the mixture of materials. Page 4 of the instant specification teaches that it is possible to combine the graphite and amorphous carbon material using other methods.

With regard to the applicant's request for an Affidavit with regard to 37 C.F.R. 1.104(d)(2), it is noted that the examiner is not relying on personal knowledge. The examiner is merely stating that the inherency of the differential thermal analysis peaks are well known in the art as admitted by the applicant in the instant specification. The specification discloses that it is known in the art that crystalline graphite has an exothermic peak at 800 °C and that amorphous carbon has an exothermic peak at 700 °C.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Examiner Correspondence

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1193. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Ruthkosky whose telephone number is 703-305-0587. The examiner can normally be reached on FLEX schedule (generally, Monday-Thursday from 9:00-6:00.) If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached at 703-308-2383.


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The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Mark Ruthkosky

Patent Examiner

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3/14/03